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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/318,268	05/25/1999	HITOSHI MATSUMOTO	Q54505	1128

7590

09/15/2003

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EXAMINER

MOUTTET, BLAISE L

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/318,268

Applicant(s)

MATSUMOTO ET AL.

Examiner

Blaise L Mouttet

Art Unit

2853

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 22 July 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): nonstatutory double patenting rejections.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-7, 9-12, 14-23 and 27-40.

Claim(s) objected to: _____

Claim(s) rejected: 8, 13 and 24-26.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Stephen D. Meier
Primary Examiner

Terminal Disclaimer

The terminal disclaimer filed on July 22, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,361,138 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Amendment

The applicant has submitted an amendment to the abstract as suggested by the examiner which is approved for entry.

Response to Arguments

Applicants terminal disclaimer has overcome the nonstatutory double patenting rejection of the final rejection. The status of the claims is now as follows.

Claims 1-7,9-12,14-23 and 27-40 are allowable.

Claims 8,13 and 24-26 are rejected.

The applicant has made the following arguments regarding the rejected claims.

Regarding the final rejection of claim 8 the applicant has argued that the combined references fail to provide a suggestion or motivation for storing data indicative of the history of the ink cartridge of Tadokoro '956 on the memory device of the cartridge of Bullock et al. '091. The applicant has made arguments that Tadokoro is concerned only with the history of a printer rather than the history information of an ink cartridge. The applicant has further argued that applicant's invention provides the

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advantage of storing history information of an ink cartridge when the ink cartridge is transferred from a first printer to a second printer.

The examiner disagrees.

Regarding applicant's first argument there is clear motivation in the Tadokoro '956 reference for the proposed combination as explained in the final rejection. Tadokoro '956 is concerned with maintenance operations of component parts of printers and stores history information in a memory to facilitate such maintenance. In the primary reference of Bullock et al. '091 the memory is provided on component parts of printers including ink cartridges.

Regarding applicant's second argument it is clear from a review of Tadokoro '956 that the history information is intended to represent the history of individual components of the printer such as an ink cartridge. While Tadokoro '956 makes reference to the history information of the printer it is clear when read in context of the reference that it is the history of the individual components of the printer with which Tadokoro '956 is concerned (see for example column 1, lines 20-28 of Tadokoro). As pointed out by the examiner in the final rejection ink cartridges are cited as one of the components considered by Tadokoro '956 (column 3, lines 38-49).

Regarding applicant's third argument it seems that the applicant is arguing inventive features that are not claimed. Claim 8 is not seen to be limited to storing information obtained from a first printer when it is placed in a second printer. The past environment of use as claimed was considered by the examiner to correspond to the same printer at an earlier time. The originally filed application is not seen to provide a

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unique definition that would conflict with the examiner's interpretation or any mention of both a first and second printer in terms of the environment of use as argued by applicant.

Thus the final rejection of claim 8 is correct.

Regarding the rejection of claims 13 and 24, the applicant has argued that Bullock et al. '091 does not store residual ink amount in the ink cartridge but instead stores this information in the printer memory.

The examiner very strongly disagrees.

The examiner clearly pointed out in the final rejection element (76) corresponding to the memory device on the ink cartridge. It is clear from a review of Bullock '091 that the residual ink amount is stored in this memory device (see column 7, lines 4-22 as pointed out in the applied rejection and, more specifically, column 8, lines 42-44).

The applicant has provided arguments amount minimal ink amount in terms of ink absorbing members and valve mechanisms of ink cartridges. However these arguments are not seen to be reflective of the claim language since no absorbing member or valve mechanisms are claimed and the definition of minimal ink amount is not seen to be limited to the terms as described by applicant's arguments.

Thus the final rejection of claims 13 and 24 is correct.

Regarding claims 25 and 26 the applicant has argued the virtue of these claims based upon their dependency from claim 24.

The examiner maintains the rejection of claim 24 as explained above and of claims 25 and 26, as dependent from 24 as finally rejected.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Blaise Mouttet whose telephone number is (703) 305-3007. The examiner can normally be reached on Monday-Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier, Art Unit 2853, can be reached at (703) 308-4896. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Blaise Mouttet September 9, 2003

Bm 9/9/2003



Stephen D. Meier
Primary Examiner